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| APPLICATION NO.    | FILING DATE      | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO |
|--------------------|------------------|----------------------|---------------------|-----------------|
| 10/823,920         | 04/14/2004       | Imtiaz Rangwalla     | 05716.0013-00000    | 6117            |
| 22852 75           | 7590 01/12/2006  |                      | EXAMINER            |                 |
| ,                  | HENDERSON, FARA  | SHEWAREGED, BETELHEM |                     |                 |
| LLP<br>901 NEW YOR | RK AVENUE, NW    |                      | ART UNIT            | PAPER NUMBER    |
|                    | N, DC 20001-4413 |                      | 1774                |                 |

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|  |  | Application No.  | Applicant(c)  | 1/1  |  |  |  |
|--|--|--|---|------|--|--|--|
|  |  | Application No.  | Applicant(s)  |      |  |  |  |
|  |  | 10/823,920   | RANGWALLA, IMTIAZ   |      |  |  |  |
|  | Office Action Summary  | Examiner   | Art Unit  |      |  |  |  |
|  |  | Betelhem Shewareged  | 1774  |      |  |  |  |
| Period fo  | The MAILING DATE of this communication app   | pears on the cover sheet with the c  | orrespondence addres:   | S    |  |  |  |
|  | • •  |  | (a) an TillnT\( (aa) n  | A)/O |  |  |  |
| WHIC<br>- Exte<br>after<br>- If NC<br>- Failu<br>Any | ORTENED STATUTORY PERIOD FOR REPL' CHEVER IS LONGER, FROM THE MAILING D. nsions of time may be available under the provisions of 37 CFR 1.1 SIX (6) MONTHS from the mailing date of this communication. It is communication to the priod of the communication of the complex of the communication of the complex of the communication of the communicatio | ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tin will apply and will expire SIX (6) MONTHS from a, cause the application to become ABANDONE | N.<br>nely filed<br>the mailing date of this commun<br>D (35 U.S.C. § 133). |      |  |  |  |
| Status   |  |  |   |      |  |  |  |
| 1)⊠  | Responsive to communication(s) filed on 14 A   | pril 2004.   |   |      |  |  |  |
|  |  | action is non-final.   |   |      |  |  |  |
|  | ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is  |  |   |      |  |  |  |
|  | closed in accordance with the practice under E   | Ex parte Quayle, 1935 C.D. 11, 45  | 53 O.G. 213.  |      |  |  |  |
| Disposit   | ion of Claims  |  |   |      |  |  |  |
| 4)⊠  | Claim(s) 1-38 is/are pending in the application.   |  |   |      |  |  |  |
| •  | 4a) Of the above claim(s) 27-37 is/are withdraw  |  |   |      |  |  |  |
| 5)   | Claim(s) is/are allowed.   |  |   |      |  |  |  |
| 6)⊠  | )⊠ Claim(s) <u>1-26,38</u> is/are rejected.  |  |   |      |  |  |  |
| 7)   | ')☐ Claim(s) is/are objected to.   |  |   |      |  |  |  |
| 8)□  | Claim(s) are subject to restriction and/o  | r election requirement.  |   |      |  |  |  |
| Applicati  | on Papers  |  |   |      |  |  |  |
| 9)   | The specification is objected to by the Examine  | r.   |   |      |  |  |  |
| 10)[   | The drawing(s) filed on is/are: a) acc   | epted or b) $\square$ objected to by the $\mathfrak l$   | Examiner.   |      |  |  |  |
|  | Applicant may not request that any objection to the  | drawing(s) be held in abeyance. See  | ∋ 37 CFR 1.85(a).   |      |  |  |  |
| _  | Replacement drawing sheet(s) including the correct   | · · · · · · · · · · · · · · · · · · ·  | •   | • •  |  |  |  |
| 11)[_  | The oath or declaration is objected to by the Ex   | aminer. Note the attached Office   | Action or form PTO-15   | 52.  |  |  |  |
| Priority ι   | ınder 35 U.S.C. § 119  |  |   |      |  |  |  |
|  | Acknowledgment is made of a claim for foreign ☐ All b)☐ Some * c)☐ None of:  |  | )-(d) or (f).   |      |  |  |  |
|  | 1. Certified copies of the priority documents  |  |   |      |  |  |  |
| •  | 2. Certified copies of the priority documents  | • •  |   |      |  |  |  |
|  | 3. Copies of the certified copies of the prior application from the International Bureau   | •  | o in this National Stag   | е    |  |  |  |
| * 5  | See the attached detailed Office action for a list   | ` ' ' '  | od.   |      |  |  |  |
|  | the attached detailed office action for a list   | or the certified copies not receive  | ·u.   |      |  |  |  |
|  |  |  |   |      |  |  |  |
| Attachmen  | t(s)   |  |   |      |  |  |  |
|  | e of References Cited (PTO-892)  | 4) Interview Summary   |   |      |  |  |  |
|  | e of Draftsperson's Patent Drawing Review (PTO-948) nation Disclosure Statement(s) (PTO-1449 or PTO/SB/08)   | Paper No(s)/Mail Da  | ate<br>atent Application (PTO-152)  |      |  |  |  |
|  | nation Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>r No(s)/Mail Date <u>11/10/05 &amp; 7/8/05</u> .   | 6) Other:  |   |      |  |  |  |
|  | 1.10%  |  |   |      |  |  |  |

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#### **DETAILED ACTION**

### Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-26 and 38, drawn to layered material, classified in class 428, subclass 195.1.
- II. Claims 27-37, drawn to method of making, classified in class 427, subclass 1+.
  The inventions are distinct, each from the other because of the following reasons:
- 2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, (i.e., providing the substrate, applying the ink formulation on the substrate, forming a thin film comprising the lacquer, and laminating the thin film on the ink side of the substrate).
- 3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
- 4. During a telephone conversation with Maria T. Bautista on 12/15/2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-26 and 38. Affirmation of this election must be made by applicant in replying to

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this Office action. Claims 27-37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

## Claim Rejections - 35 USC § 103

- 5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 6. Claims 1-26 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rangwalla et al. (US 2003/0001108 A1) in view of Pennaz (US 5,382,282).

Rangwalla discloses a packaging material comprising a substrate, a lacquer coating on the substrate, and an ink print layer between the substrate and the ink print layer, wherein the lacquer coating substantially identical to the claimed lacquer ([0097]-[0108]), and has a normalized thickness of 0.5-20 g/m² [0109]. The substrate is disclosed in [0112]. The lacquer is curable by particle beam machine [0110] and [0111]. Sandwiching the print layer and any intermediate layer between materials that are used for forming the substrate is well known in the packaging material art (see Example 8). The ink in the print layer can be electron beam curable [0116]. Rangwalla does not disclose the claimed ink composition.

Pennaz teaches an electron beam curable ink composition for printing, wherein the ink composition is disclosed in (col. 20, lines 1-43).

Rangwalla and Pennaz are analogous art because they are from the same field of endeavor that is the particle beam curable material art. At the time of the invention, it

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would have been obvious to a person of ordinary skill in the art to combine the ink composition of Pennaz with the invention of Rangwalla so as to provide a printed packaging material containing ink composition having enhanced water stability and viscosity (see col. 19, line 38 of Pennaz).

#### Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B.S. January 7, 2006.

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